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In re Application of
HOFFMAN, Arnold
Application No. 10/621,326
Filed: July 18, 2003
Attorney Docket No. HOFFMAN9

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the "Petition For Reinstatement Of Priority Claim Under 35 U.S.C. 365(b)" filed May 28, 2008. The petition requests reinstatement of a benefit claim to prior-filed international application PCT/IL02/00051. The benefit claim was included in the application as filed, but it was subsequently deleted from the application by applicants.

There is no mechanism by which a request to reinstate a previously withdrawn benefit claim would be treated differently than a request to add any other untimely benefit claim. Accordingly, the present request has been treated as a petition under 37 CFR 1.78(a)(3) to accept an untimely claim under 35 U.S.C. 120 and 365(c) for the benefit of the prior-filed PCT application. Applicants have submitted the required petition fee.

The petition is **DISMISSED** without prejudice.

The present nonprovisional application was filed after November 29, 2000, and the claim for the benefit of priority to the prior-filed PCT and foreign application contained in the present submission is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The

Director may require additional information where there is a question whether the delay was unintentional.

The present petition fails to satisfy items (1) and (3).

With respect to item (1), the amended continuity reference submitted by applicants fails to properly set forth the international application number, as required (the last digit of the international application number is missing).

With respect to item (3), the first page of the specification originally filed herein included a reference identifying the application as “a continuation-in-part of application No. PCT/IL02/00051, filed January 18, 2002” However, as set forth in the amendment filed by applicants on 03 January 2007, applicants expressly deleted this benefit claim: “Applicants hereby withdraw there reliance for benefit on both the Israeli priority application as well as the PCT international application of the which the present application was previously designates as a CIP.” The withdrawal of the claim of benefit for the international application was confirmed in the amendment to the first page of the specification filed 13 February 2007, which removed the indication that the present application was a continuation-in-part of the international application.

The present petition states that “the withdrawal of the priority claim to PCT/IL02/0005 [sic] was an inadvertent mistake.” However, the petition does not indicate that the entire delay between the date the claim was due and the filing of the present petition was unintentional, as required, nor does it appear that such a statement would be appropriate under the present facts, where the desired benefit claim was expressly and intentionally removed from the application. See MPEP section 201.11(III)(G):

A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

Based on applicants’ failure to satisfy all the requirements of a grantable petition under 37 CFR 1.78(a)(3), the request to add the untimely benefit claim to international application PCT/IL02/00051 is properly dismissed.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Richard M. Ross at (571) 272-3296.



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